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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,370	03/29/2001	Todd P. Beach	TMADE.067A	3442
30764	7590	04/25/2005		
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448			EXAMINER PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,370

Applicant(s)

BEACH ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25 is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

This Office action is responsive to communication received 07/12/2004 – Request for extension of time, Request for Continued Examination (RCE) and Amendment.

Claims 1-30 remain pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26-28 STAND rejected under 35 U.S.C. 102(e) as being anticipated by Yoneyama ('132), as stated in the last rejection, mailed 02/10/2004. When the club head volume is 250 cc, Yoneyama provides that the balance weight (10) should provide between 8 and 10% of the total weight of the head. This is evident from the language in col. 3, lines 53-56, wherein Yoneyama discloses a volume between 150 and 250 cc. This range is deemed to include the lower limit of 150 cc as well as the upper limit of 250 cc. Thus, the claimed limitations are anticipated. No further explanation is deemed necessary.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama ('132) in view of Bowland ('283) and Helmstetter ('788). Reference is made to col. 2, lines 6-15 along with col. 3, lines 48-59 in Yoneyama, wherein a discussion is made relating the volume of the head to the % weight of the balance weight (10) in the sole. Although one may argue that the exact percentage of weight material required by applicant's claims as well as the volume greater than 300 cc is not explicitly disclosed in Yoneyama, the skilled artisan would have found it obvious to modify the % weight of the balance weight in Yoneyama, given that it would have been desirable to alter the overall weight of the head to attain a specific swing weight suited to an individual golfer's needs. As for the claimed volume, oversized club heads having a volume in excess of 300 cc are well-known in the art. Bowland teaches that a sole weight may be modified in order to come up with a preferred swing weight (col. 3, lines 19-25). Helmstetter also acknowledges that the volume of the head as well as the amount of balance weight added proximate the sole may be varied depending on the preference of the golfer. Further, Helmstetter obviates the inclusion of a club head volume greater than 300 cc. See col. 2, lines 7-10 and col. 3, lines 35-64 along with col. 4, lines 37-57 and col. 5, lines 10-52. In view of the teachings in Bowland and Helmstetter, it would have been obvious to modify the club head volume and % weight of the balance weight (10) in Yoneyama for the reasons advanced in Bowland and Helmstetter, specifically, to tailor the head to the needs of a particular golfer.

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Allowable Subject Matter

Claims 1-25 are allowable over the prior art references of record in view of applicant's arguments on page 7, last complete paragraph, and page 11, lines 12-20 of the arguments received 07/12/2004.

RESPONSE TO ARGUMENTS

Applicant's arguments with respect to claims 26-30 have been considered but are moot in view of the new ground(s) of rejection.


Any inconvenience to the applicant due to the lack of addressing claim 30 in an earlier rejection is sincerely regretted. However, the interview of 07/23/2004 was deemed to satisfactorily answer the applicant's questions with respect to the relevance of the prior art as it may apply to claim 30 on the merits.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
April 15, 2005